

REMARKS

This Amendment is submitted in response to the Office Action dated December 23, 2009, having a shorted statutory period set to expire March 23, 2010.

I. Rejection under 35 U.S.C. § 112, 1st paragraph

At page 2 of the present Office Action, all pending claims are rejected under 35 U.S.C. § 112, 1st paragraph, as allegedly failing to enable “analyzing the data page to determine an orientation for presentation of the data page relative to the first and second dimensions of the display” as recited in Claim 28. Applicant respectfully traverses this rejection and respectfully points out that page 8, line 23 *et seq.* clearly teaches that one technique for analyzing the data page to determine a best-fit orientation would be to examine the line width of the data page.

While acknowledging the teaching of the present specification, the Examiner rhetorically asks “how does it work with different font sizes?” and “What if the data page is a picture?” In response, Applicant respectfully points out that a “line width” is independent of font size and whether the data page is contains text or image data. Thus, regardless of the font size of textual data or whether a data page contains image data, the present specification clearly enables a person of ordinary skill in the art at the time of the invention to make and use a portable device that “analyz[es] the data page to determine an orientation for presentation of the data page relative to the first and second dimensions of the display.” Applicant therefore respectfully submits that the rejection of all pending claims under 35 U.S.C. § 112, 1st paragraph, is not well founded and should be withdrawn.

At page 3 of the present Office Action, the Examiner additionally rejects Claims 20-21, 23-26, 30 and 33 under 35 U.S.C. § 112, 1st paragraph, as failing to provide written description supporting the recitation of “a computer-readable [storage] medium.” Again, Applicant respectfully traverses the rejection under 35 U.S.C. § 112, 1st paragraph, and respectfully draws the Examiner’s attention to page 8, line 30 *et seq.* of the present specification, which discloses:

Examples of computer usable mediums include: nonvolatile, hard-coded type mediums such as read only memories (ROMs) or erasable, electrically programmable read only memories (EEPROMs), recordable type mediums such as floppy disks, hard disk drives and CD-ROMs.

Thus, the present specification clearly discloses “computer usable mediums” on which data may be stored and from which data may be read. As noted, examples of such computer readable storage media include memories (e.g., ROMs, EEPROMs, etc.), magnetic storage media (e.g., floppy disks, hard disk drives, etc.) and optical storage media (e.g., CD-ROMs). Thus, while the present specification does not explicitly use the term “computer-readable storage medium” as recited in Claim 30, Applicant submits that the present specification provides written description adequate to remove all doubt that “a skilled artisan would have understood the inventor to be in possession of the claimed invention at the time of filing.” *MPEP 2163*, citing *Vas-Cath*, 935 F.2d at 1563, 19 USPQ2d at 1116 and *Martin v. Johnson*, 454 F.2d 746, 751, 172 USPQ 391, 395 (CCPA 1972) (stating “the description need not be in *ipsis verbis* [i.e., “in the same words”] to be sufficient”). Consequently, the rejection of Claims 20-21, 23-26, 30 and 33 under 35 U.S.C. § 112, 1st paragraph, is not well founded and should be withdrawn.

II. Rejection under 35 U.S.C. § 103

At page 3 of the present Office Action, Claims 2-8, 11-12, 14-17, 20-21, 23-26 and 28-30 are rejected under 35 U.S.C. § 103 as unpatentable over U.S. Patent No. 5,661,632 to *Register* in view of U.S. Patent No. 6,453,173 to *Reber et al. (Reber)*. That rejection is respectfully traversed, and favorable reconsideration of the claims is requested.

The combination of *Register* and *Reber* does not render exemplary Claim 28 unpatentable under 35 U.S.C. § 103 because that combination does not disclose the “analyzing” step set forth in Claim 28 as follows:

the portable device analyzing the data page to determine an orientation for presentation of the data page relative to the first and second dimensions of the display.

With reference to this feature, page 4 of the present Office Action cites Figures 4-5 of *Register*, claiming erroneously that “they are self[-]explanatory” and disclose the claimed step of

“analyzing the data page to determine an orientation.” Applicant respectfully traverses this assertion because it is manifestly contrary to the plain teaching of the references. When the references are actually examined, it is clear that the combination of *Register* and *Reber* discloses:

Turning now to FIGS. 4 and 5, according to a primary aspect of the present invention, the handheld computer 10 is specially designed to be operated by a user in a selectively variable one of two different display screen orientations--a "portrait" orientation (FIG. 4) in which the length of the display screen 26 is vertically oriented, and a "landscape" orientation (FIG. 5) in which the length of the display screen is horizontally oriented and rotated ninety degrees in a counterclockwise direction from its FIG. 4 portrait orientation. [*Register*, col. 2, line 61 *et seq.*]

According to a key aspect of the present invention, to accommodate this reorientation of the computer 10 the orientation of its display screen image 52, as well as the command text and/or graphics C within the command icons 54a, 54b may be similarly rotated ninety degrees in a clockwise orientation using one of the toggle buttons 28, 30, 32 and 34 (representatively the toggle button 34). As may be seen by comparing FIGS. 4 and 5, this display reorientation causes both the display screen image 52 and the command text and/or graphics C to be in an "upright" viewing orientation when the computer is shifted from its FIG. 4 portrait orientation to its FIG. 5 landscape orientation. In a manner subsequently described herein the orientation of the display screen image 56 and the command text and/or graphics C may be also switched back to their FIG. 4 portrait orientation using the toggle button 34. [*Register*, col. 3, line 65 *et seq.*]

In other words, the combination of *Register* and *Reber* discloses only that a user can toggle between portrait and landscape display modes using toggle buttons. The combination of *Register* and *Reber* utterly fails to disclose any analysis of a data page to determine the orientation of display for the data page. Consequently, the rejection of exemplary Claim 28, similar Claims 29-30 and their respective dependent claims under 35 U.S.C. § 103 in view of the combination of *Register* and *Reber* is not well founded and should be withdrawn.

The rejection of Claim 6 is similarly not well founded and should be withdrawn. At page 7 of the present Office Action, the Examiner asserts without any basis that the features recited in Claim 6 would have been obvious to those skill in the art. Because the Examiner's unsupported assertion of obvious does not have any evidential weight, Applicant respectfully submits that the

Examiner has failed to make a *prima facie* case of obviousness with respect to Claim 6 or similar Claims 15 and 24.

The rejection of Claim 7 is similarly not well founded and should be withdrawn. At page 7 of the present Office Action, the Examiner notes that *Register* fails to disclose a “wireless telephone” as claimed, but instead discloses a personal digital assistant. Because the Examiner has failed to make a *prima facie* case of obviousness with respect to Claim 7, Applicant respectfully submits that the rejection of Claim 7 and similar Claims 16 and 25 under 35 U.S.C. § 103 is overcome.

III. Summary

Having responded to each rejection set forth in the present Office Action, Applicant respectfully submits that exemplary Claim 28, similar Claims 29-30, and their respective dependent claims are not rendered unpatentable by the combination of *Register* and *Reber* under 35 U.S.C. § 103.

Please charge any additional fees that are required to IBM Corporation Deposit Account No. **09-0447**.

Respectfully submitted,

/Brian F. Russell/

Brian F. Russell
Reg. No. 40,796
DILLON & YUDELL LLP
8911 N. Capital of Texas Highway
Suite 2110
Austin, Texas 78759
512-343-6116